

### **REMARKS**

This paper responds to the Office Action mailed on November 29, 2006, and the references cited therewith. Claims 7, and 26 are amended and claims 1-6, 10, 21-25, 29 and 30 are canceled such that claims 7-9, 11-20, 26-28 and 31 are now pending in this application.

#### **First §102 Rejection of the Claims**

Claims 1-4, 6, 21, 23 and 25 were rejected under 35 U.S.C. § 102(e) for anticipation by Daneshvar (2003/0149389 A1). Applicant has canceled claims 1-4, 6, 21, 23 and 25 such that the rejection is moot.

#### **Second §102 Rejection of the Claims**

Claims 7-12 were rejected under 35 U.S.C. § 102(e) for anticipation by Chalek (US 6,936,018 B2). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* '2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As part of making the rejection, the Examiner states at page 4 of the Office Action that "Chalek discloses the flexible wrap of claim 7 wherein each of said plurality of fingers is integral with the elastic band (Fig 1, column 5 lines 18-19)." Applicant respectfully traverses the assertion because the portions of Chalek that are cited by the Examiner show that the attachment elements 26 are "affixed to the distal end 24" of the strip 12.

Applicant can not find any teaching or suggestion in Chalek that the disclosed attachment elements 26 are integral with the strip 12. Therefore, Chalek does not describe "wherein each of said plurality of fingers is integral with said elastic band" as recited in amended claim 7. Claims 8-9 and 11-12 depend from claim 7, and are patentable over Chalek for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 7-9 and 11-12 are respectfully requested.

Third §102 Rejection of the Claims

Claims 21-22, 24 and 26-31 were rejected under 35 U.S.C. § 102(b) for anticipation by Peterson (US 5,538,500). Applicant has canceled claims 21-22, 24, 29 and 30 such that the rejection is moot as to those claims.

Applicant can not find any teaching or suggestion in Peterson that one end 16 of the disclosed bandage wrap 12 is attached to the body using an adhesive while the opposing end 18 of the bandage wrap 12 is attached to an exposed section of the bandage wrap 12. Applicant notes that tape 28 in Peterson is only described as being in the wound-covering section 14 of the bandage wrap 12, which is not on either end of the bandage wrap 12 (see Fig. 1 and col. 4, line 66 through col. 5, line 18 of Peterson).

Therefore, Peterson does not describe “attaching one end of an elastic band to skin on the body using an adhesive” in combination with “securing a plurality of fingers that project from an opposing end of the elastic band to an exposed section of the elastic band” as recited in amended claim 26. Claims 27-28 and 31 depend from claim 26, and are patentable over Peterson for the reasons argued above, plus the elements in the claims.

Reconsideration and allowance of claims 26-28 and 31 are respectfully requested.

First §103 Rejection of the Claims

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Daneshvar as applied to claim 1 above, and further in view of Hymes (US 6,455,065 B1) and Podell et al. (US 5,620,702). Applicant has canceled claim 5 such that the rejection is moot.

Second §103 Rejection of the Claims

Claims 13 and 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson. To sustain a rejection under 35 U.S.C. 103, references must be cited that teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc.*

*v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

Claim 13

Applicant respectfully traverses the rejection of claim 13 because Peterson does not describe each and every element of the claimed invention. As discussed above, Applicant can not find any teaching or suggestion in Peterson that one end 16 of the disclosed bandage wrap 12 is attached to the body using an adhesive while the opposing end 18 of the bandage wrap 12 is attached to an exposed section of the bandage wrap 12. Applicant notes that the tape 28 in Peterson is only described as being in the wound-covering section 14 of the bandage wrap 12, which is not on either end of the bandage wrap 12 (see Fig. 1 and col. 4, line 66 through col. 5, line 18 of Peterson).

Therefore, Peterson does not describe “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body, wherein said adhesive layer is adapted to be detachably mounted to skin on the body” in combination with “a plurality of fingers extending from said second end of said elastic band” as recited in claim 13. The Examiner appears to acknowledge this at page 8 of the Office Action by stating “Peterson does not disclose having the adhesive layer near the first end.”

The Examiner attempts to overcome the acknowledged deficiencies of Peterson by stating at page 8 of the Office Action that

“it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive at an end of the elastic band in order to secure the flexible wrap to the skin at an end of the wrap instead of in the middle.”

Applicant respectfully traverses these assertions in part because Peterson does not teach or suggest an adhesive layer mounted on an end of the elastic band to secure the elastic band to a body. Applicant respectfully submits that the statements made by the Examiner regarding a motivation to modify Peterson are mere conclusory statements of subjective belief because the

statements are analogous to the unsatisfactory statements made by the Examiner and board in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

"With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software' and that 'another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial' do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use '[use] that which the inventor taught against its teacher.' *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)." *Lee*, at 1343, 1344."

Applicant respectfully notes that the Examiner provides no support for the assertions relating to modifying Peterson which were made in the Office Action. Applicant respectfully submits that the only teaching or suggestion relating to a flexible wrap as recited in claim 13 is found in Applicant's disclosure.

Applicant also respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements in the claims are found in Peterson. Applicant respectfully requests that the Examiner cite with particularity where each of elements in claim 13 are found in Peterson.

If the Examiner does not cite with particularity where each of elements in claim 13 are found in Peterson, Applicant will assume that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Reconsideration and allowance of claim 13 are respectfully requested.

Claims 15-19

Applicant respectfully traverses the rejection of claims 15-19 because Peterson does not describe each and every element of the claimed invention. Applicant can not find any teaching or suggestion in Peterson as to a fastener that extends along a midsection of a pack such that the fastener secures the pack to an elastic band. Applicant notes that Peterson only describes attaching the absorbent pad 24 to the bandage wrap 12 about the absorbent pad's 24 circumference or sides (see Peterson at col. 4, lines 15-18).

Therefore, Peterson does not describe "a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band" as recited in claim 15. The Examiner appears to acknowledge this at page 8 of the Office Action by stating "Peterson does not disclose a fastener along the midsection of the pack, but does teach that the pack need not be secured to the wrap entirely around its circumference (column 4 lines 15-17)."

The Examiner attempts to overcome the acknowledged deficiencies of Peterson by stating at page 8 of the Office Action that

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the manufacturing of the invention."

Applicant respectfully traverses these assertions in part because Peterson does not teach or suggest a fastener on a midsection of a pack. Applicant respectfully submits that the statements made by the Examiner regarding a motivation to modify Peterson are again mere conclusory statements of subjective belief because the statements are analogous to the unsatisfactory statements made by the Examiner and board in *In re Lee* (see quote from *Lee* case above).

Applicant respectfully notes that the Examiner provides no support for the assertions relating to modifying Peterson which were made in the Office Action. Applicant respectfully submits that the only teaching or suggestion relating to a flexible wrap as recited in claim 15 is found in Applicant's disclosure.

Applicant also respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements in the claims are found in Peterson. Applicant respectfully

requests that the Examiner cite with particularity where each of elements in claim 15 are found in Peterson.

If the Examiner does not cite with particularity where each of elements in claim 15 are found in Peterson, Applicant will assume that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

The Examiner further acknowledges at page 9 of the Office Action with regard to claim 17 that Peterson does not disclose a single adhesive layer that extends along the midsection of the pack. Applicant agrees and again notes that Peterson only describes attaching the absorbent pad 24 to the bandage wrap 12 about the absorbent pad's 24 circumference or sides (see Peterson at col. 4, lines 15-18).

The Examiner attempts to overcome the acknowledged deficiencies of Peterson by stating at page 9 of the Office Action that

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Peterson by placing the adhesive layer so it extends along the midsection of the pack in order to reduce the amount of adhesive needed to secure the pack to the elastic band or to reduce the complexity required during the of manufacturing the invention.

Applicant respectfully submits that the statements made by the Examiner regarding a motivation to modify Peterson are again mere conclusory statements of subjective belief because the statements are analogous to the unsatisfactory statements made by the Examiner and board in *In re Lee* (see quote from *Lee* case above). Applicant respectfully notes that the Examiner provides no support for the assertions relating to modifying Peterson which were made in the Office Action.

Reconsideration and allowance of claims 15-19 are respectfully requested.

*Third §103 Rejection of the Claims*

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson as applied to claim 13 above, and further in view of Daneshvar. Applicant respectfully traverses

the rejection because the combination of Peterson and Daneshvar does not describe each and every element of the claimed invention.

As discussed above, Peterson does not teach or suggest “an adhesive layer mounted on said elastic band near said first end to secure said elastic band to a body, wherein said adhesive layer is adapted to be detachably mounted to skin on the body” in combination with “a plurality of fingers extending from said second end of said elastic band” as recited in claim 13. Applicant notes that Daneshvar also does not describe these limitations.

Claim 14 depends from claim 13 and as such incorporates all of the limitations of claim 13. Therefore, Applicant respectfully submits that the combination of Peterson and Daneshvar does not teach or suggest a flexible wrap as recited in claim 14.

*Fourth §103 Rejection of the Claims*

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson as applied to claim 16 above, and further in view of Hymes and Podell. Applicant respectfully traverses the rejection because the combination of Peterson with Hymes and Podell does not describe each and every element of the claimed invention.

As discussed above, Peterson does not teach or suggest “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band” as recited in claim 15. Applicant notes that Hymes and Podell also do not describe “a fastener extending along said midsection of said pack such that said fastener secures said pack to said elastic band” as recited in claim 15.

Claim 20 depends from claim 15 and as such incorporates all of the limitations of claim 15. Therefore, Applicant respectfully submits that the combination of Peterson with Hymes and Podell does not teach or suggest a flexible wrap as recited in claim 20.

*Reservation of Right to File Continuation or Divisional Applications*

Applicant respectfully traverses the pending 35 USC § 102 & 103 rejections. Applicant reserves the right to file a continuation application relating to any of the original and/or canceled claims at a later date. Applicant also respectfully reserves the right to traverse any statements in

the Office Action relating to the rejections (e.g., under MPEP 2144.04 among other things).

Applicant is expressly not admitting to any assertions made in the Office Action.

*Reservation of Right to Swear Behind References*

Applicant reserves the right to swear behind any references which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.



**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date January 31, 2007

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